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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,061	04/15/2004	Hirohisa Koyama	04240/LH	9480

1933 7590 01/11/2006

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EXAMINER

CHAN, WING F

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/826,061	Applicant(s) KOYAMA ET AL.	
	Examiner Wing F. Chan	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 3, 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 12 are vague and indefinite in that there appears to be no differences between the two imaging modes since the image is derived from the same imaging means.

Claims 3, 13, which depend on claims 2, 12 respectively, also contain the same problem.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 19 taken as a whole is directed merely to a computer software program recited as "causes a computer including a communication unit, an imaging unit and a display panel to execute" instructions. The body of the claim recites elements of the computer software program in the form of descriptions or expressions of steps and nothing more. Thus, taken as a whole, the scope of independent claim 19 amounts to

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merely a computer software program, without any computer-readable medium to realize the potential functionality or intended use of the program.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 6-8, 11, 12, 15, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato et al (EP 1 067 748 hereinafter Sato).

As to claims 1, 11, Sato discloses an imaging apparatus with communication function comprising communicating means (e.g. 408 in Fig. 13), address book means (e.g. see Figs. 1, 2, [0064]), control means (402) for instructing a mode used to created contact data, imaging means (not shown but inherent, see [0021] for example), image storing means (411). Also see [0064-0073], Figs. 13-14.

As to claims 2, 12, 19, see Sato [0067] for example where the display parameters specifying the size, number of pixels, etc. are stored for each display type.

As to claims 6, 15, note that Sato discloses providing an image of the caller as the notification method.

As to claims 7, 8, note the parameter setting disclosed by Sato, e.g. [0067].

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7. Claims 1, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hsu (US PAT. NO. 5,907,604)).

As to claims 1, 11, Hsu discloses an imaging apparatus (e.g. see Figs. 1, 2) with communication function comprising communicating means (e.g. 102), address book means (e.g. 356), control means for instructing a mode used to created contact data, imaging means (282, 290, 350 for example), image storing means (356, col. 5 lines 47-49). See Fig. 1-8, col. 5 line 32 to col. 6 line 43, for example.

8. Claims 1, 6, 11, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamimura (US PG PUB. NO. 2002/0094806).

As to claims 1, 6, 11, 15, Kamimura discloses an imaging apparatus (e.g. see Fig. 1) with communication function comprising communicating means (e.g. 10), address book means (e.g. 60a), control means (100) for instructing a mode used to created contact data, imaging means (90), image storing means (60b). See all figures, abstract, [0010, 0023-0090].

9. Claims 1, 4, 5, 11, 14, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito (EP 1 033 857).

As to claims 1, 11, Ito discloses an imaging apparatus (e.g. see Figs. 1, 2, 6) with communication function comprising communicating means (e.g. 1, 2 in Fig. 3), address book means (e.g. memory 15), control means (11) for instructing a mode used to

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created contact data, imaging means (17), image storing means (18). See col. 4 line 52 to col. 5 line 42, col. 5 line 46 to col. 8 line 24.

As to claim 4, see [0028].

As to claims 5, 15, see [0033, 0034, 0037-0039, 0048].

As to claim 14 see [0034, 0047].

10. Claims 1, 4, 5, 11, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Aoki et al (EP 0 930 770 hereinafter Aoki).

As to claims 1, 11, Aoki discloses an imaging apparatus (1) with communication function comprising communicating means (e.g. 27), address book means (e.g. 22, 26, 29), control means (28) for instructing a mode used to created contact data (e.g. col. 7 lines 14-16, where the “managing” for the information inherently includes “creation” and “editing”), imaging means (21 for example), image storing means (22). See entire document.

As to claims 4, 11, 14, see Aoki Fig. 9, [0069-0072] for example.

As to claim 5, note Aoki Fig. 11, [0080-0083], note the merge function and scenic view.

11. Claims 2, 7-10, 12, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki in view of Koyama (JP 2001-274979), Bjorn (US PG PUB. NO. 2002/0049071) and Sato et al (EP 1 067 748 hereinafter Sato).

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As to claims 2, 9, 10, 12, 18, 19, Aoki differs from the claimed invention in not disclosing the imaging apparatus is able to control the display screen to display either camera images or phonebook images. However, it is old and well known in the art that phonebook entries use thumbnails, by definition of a lower resolution, for example see Koyama, Figs. 1-11, [009, 0010, 0016-0020, 0044, 0045, 0049, 0056, 0059, 0060, 0066-0070]; and Bjorn paragraph [0048]. It is also old and well known in the art for an imaging apparatus to store display parameters specifying the size, number of pixels, etc. associated with its own display to properly display the image. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aoki to comprise means for storing display parameters specifying the size, number of pixels, etc. associated with its own display to properly display the image whether it is a camera image or phonebook image (thumbnail) such that the image is recognizable by the viewer.

As to claims 7, 8, 16, 17, all the applied references discloses using a built-in camera to supply images or thumbnails for a phonebook function, thus it would have been expedient obvious to one of ordinary skill in the art at the time the invention was made to limit the imaging options to those suitable for such as use (to correspond to the stored image parameters) to save time and power when using the apparatus for the phonebook function.

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12. Claims 3, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki as modified by Koyama, Bjorn and Sato as applied to claims 2, 12 above, and further in view of Ito (EP 1 033 857).

As to claims 3, 13, Ito teaches that more than one image can be associated with a single telephone number and be displayed sequentially (continuously) at an incoming call (e.g. paragraph [0034], also note paragraphs [0033, 0047]). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the imaging device in Aoki as modified by Koyama, Bjorn and Sato to comprise a continuous pickup means such that a plurality of frames of the image is associated with the contact data and the images "can be changed at each incoming call or at each time zone or be displayed sequentially" to identify the calling party thus making the caller identification function more flexible and easy to make proper identification (e.g. Ito col. 2 lines 35-49).

13. Claims 6, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki as modified by Koyama, Bjorn and Sato as applied to claims 2, 12 above, and further in view of Kamimura (US PG PUB. NO. 2002/0094806).

As to claims 6, 15, it is old and well to use different ring tones, image effects, etc. associated with a telephone number for easily identifying the calling party (notifying) the called party as to whom is calling, for example see Kamimura abstract, [0008]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aoki as modified by Koyama, Bjorn and Sato to use different ring tones,

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image effects, etc. associated with a telephone number for easily identifying the calling party.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sato (EP 0 436 345) discloses a voice and image communication apparatus.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wing F. Chan whose telephone number is 571-272-7493. The examiner can normally be reached on Monday to Friday from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wing F. Chan
Primary Examiner
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12/22/05